UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,953	04/19/2005	Takashi Hosoda	Q87576	4306

23373 7590 01/03/2011

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
GOLIGHTLY, ERIC WAYNE	
ART UNIT	PAPER NUMBER
1714	

NOTIFICATION DATE	DELIVERY MODE
01/03/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No.	Applicant(s)	
	10/531,953	HOSODA ET AL.	
	Examiner	Art Unit	
	Eric Golightly	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 6-15* is/are pending in the application.

4a) Of the above claim(s) *6-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' amendment filed 11/3/2010 is acknowledged. Claims 1-3 and 6-15 are pending. Claims 6-15 are withdrawn. Claims 4 and 5 are cancelled.

Claim Objections

2. Claim 1 is objected to because of the following informality:

In claim 1, the comma immediately following the word "and" should apparently be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

Claim 1 recites the limitation "the upper side" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-353650 to Tabata et al (see machine translation and hereinafter "Tabata") and in view of EP 0764478 to Maekawa et al (hereinafter "Maekawa") and in further view of JP S64-23224 to Murakami et al (hereinafter "Murakami").

As to claim 1, Tabata discloses a scrubbing method to clean an optical component such as an optical lens form block (lens mold) (Page 2, Paragraph [0001]), where the lenses are made from plastic (Page 7, Paragraph [0026]). The method comprises a washing step of rotating the optical component while pressing an elastic polishing member against a surface of the optical component while rotating the polisher (Page 8, Paragraphs [0030]-[0032]). During this process, a liquid may be applied to wash the optical component, which is understood to be supplied to the area between the surface of the optical component and the elastic polishing member (Page 9, Paragraph [0035]; Figure 1). Tabata teaches that the liquid may be water (Page 9, Paragraph [0035]). Tabata further discloses using a liquid discharge port (Fig. 1, ref. 6 and 7 and paragraph [0034]) which moves with the polishing member continuously supplying liquid to the polisher (paragraph [0034]).

Tabata discloses that the pressure in the elastic polishing member may be adjusted to change the shape of the polisher, so it is understood to be deformable (Page 7, Paragraph [0024]). Tabata is silent regarding a self-washing step of rotating the elastic polishing member in a position spaced from a position which said washing step is conducted in, and supplying the same liquid used in the washing step to the elastic polishing member, deforming the elastic polishing member by pressing the

elastic polishing member against a rod-like or hollow cylindrical pressing unit so as to thereby wash the polishing unit, wherein the washing and self-washing are performed alternately, and using a polishing member including liquid-permeable sponge. Maekawa discloses a self-washing step of rotating a cleaning member comprising a layer of liquid-permeable sponge (i.e. elastic polishing member) wound around a cleaning roller, in a position spaced from a position in which said washing step is conducted, supplying a liquid to the cleaning member and deforming the cleaning member by pressing the elastic polishing member against a hollow pressing unit (Fig. 5, ref. 24 and 29 and col. 8, lines 5-8, 46 and 47) in order to wash the cleaning member (Col. 8, lines 5-10, 37-59; Col. 9, lines 1-13). Maekawa teaches that the liquid used in the self-washing step may be water (Col. 7, lines 28-32), which is the same liquid used in the washing step of Tabata (Tabata at Page 9, Paragraph [0035]). Maekawa teaches that the self-washing step is performed after the washing step is conducted, meaning that they are conducted alternately (Col. 8, lines 37-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method taught by Tabata to include a self-washing step as taught by Maekawa for the benefit of removing contamination that comes to adhere to the surface of a cleaning body during a cleaning process, thereby increasing the cleaning effect and prolonging the service life of the cleaning body (Col. 2, lines 29-35; Col. 9, lines 6-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to include using a polishing member including liquid-permeable sponge as disclosed by Maekawa in the method of the Tabata teaching due to the high volume and speed of absorption, ease of molding,

and durability of PVA sponges. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the self-washing step in a spaced apart position to prevent the lens mold from being recontaminated by the self-washing step. It is noted that liquid supplied from the port (Tabata Fig. 1, ref 6 and 7 and paragraph [0034] will be supplied to an upper side of the polishing member since it will permeate the sponge and since it is rotated to an upper side (Tabata Fig. 1, note leftmost circular arrows).

Tabata and Maekawa disclose using a hollow pressing unit that is a rectangular prism rather than cylindrical (Maekawa at Fig. 5, ref. 24 and 29 and paragraph [0046]). The skilled artisan would have found it a matter of obvious choice to use a hollow pressing unit that is cylindrical in shape rather than a rectangular prism. MPEP 2144.04(IV)(B).

As to claim 2, Tabata and Maekawa further disclose that the liquid may be a slurry containing an abrasive dispersed in water (Tabata at Page 9, Paragraph [0035]). While the combination of Tabata and Maekawa does not expressly disclose using this liquid for the self-washing step, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a slurry containing an abrasive dispersed in water for the cleaning liquid in the self-cleaning step for the benefit of enhancing the self-washing process.

As to claim 3, Tabata and Maekawa further discloses that the liquid may be water (Tabata at Page 9, Paragraph [0035]) and Maekawa at Col. 7, lines 28-32).

Response to Amendment

9. The rejections under 35 USC 112, second paragraph, are withdrawn in view of the amendment. New rejections under 35 USC 112, second paragraph, are made herein as discussed above in the section "Claim Rejections - 35 USC § 112".

Response to Arguments

10. Applicants' arguments filed 11/3/2010 have been fully considered but they are not persuasive.

Regarding applicants' argument that the applied art does not teach or suggest using a hollow pressing unit since, it is alleged, the Maekawa (EP 0764478) discloses pressing the pressing unit against a plate (remarks at page 7, last full paragraph), it is noted the referenced plate, i.e. Maekawa ref. 29, is part of a pressing unit which also includes a hollow portion, i.e. Maekawa ref. 24. See esp. Maekawa Figs. 5 and 6 and col. 8, lines 46 and 47.

Applicants' assertions that the present invention results in more efficient self-washing than the applied art (remarks at page 7, last full paragraph), or that a polishing member used a method in the Tabata (JP 2001-353650) disclosure (remarks, paragraph bridging pages 7 and 8) deal with the perceived benefits of the present invention and not with the issues of rejection.

In response to applicants' question of how the Tabata method could be modified to include a self-washing step as in the Maekawa method (remarks, paragraph bridging pages 7 and 8), the test for obviousness is not whether the features of a secondary

reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicants' assertion that there is no teaching, suggestion, or motivation to combine the references (remarks, paragraph bridging pages 7 and 8), the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method taught by Tabata to include a self-washing step as taught by Maekawa for the benefit of removing contamination that comes to adhere to the surface of a cleaning body during a cleaning process, thereby increasing the cleaning effect and prolonging the service life of the cleaning body (Maekawa at Col. 2, lines 29-35; Col. 9, lines 6-13)

Regarding applicants' argument that the applied art does not teach or suggest using a liquid permeable sponge (remarks, paragraph bridging pages 7 and 8) and using a liquid discharge port (remarks at page 8, first full paragraph) as recited in the

present amendment, it is noted that Maekawa discloses a self-washing step of rotating a cleaning member comprising a layer of liquid-permeable sponge (i.e. elastic polishing member) wound around a cleaning roller (Fig. 5, ref. 24 and 29 and col. 8, lines 5-8, 46 and 47). Tabata discloses using a liquid discharge port (Fig. 1, ref. 6 and 7 and paragraph [0034]) which moves with the polishing member continuously supplying liquid to the polisher (paragraph [0034]). It is noted that liquid supplied from the port (Tabata Fig. 1, ref 6 and 7 and paragraph [0034] will be supplied to an upper side of the polishing member since it will permeate the sponge and since it is rotated to an upper side (Tabata Fig. 1, note leftmost circular arrows).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Golightly whose telephone number is (571) 270-3715. The examiner can normally be reached on Monday to Thursday, 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./
Examiner, Art Unit 1714
/Michael Kornakov/
Supervisory Patent Examiner, Art Unit 1714